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| 09/930,441 | 08/16/2001 | Sang Sun Lee | HI-0042 | 1268 |

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CHANTILLY, VA 20153

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| EXAMINER |
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NGUYEN BA, HOANG VU A

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| ART UNIT | PAPER NUMBER |
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2623

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/26/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/930,441

Applicant(s)

LEE, SANG SUN

Examiner

Hoang-Vu A. Nguyen-Ba

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed October 11, 2006.
2. Claims 1-18 are pending. Claims 1, 8, 10, 11, 16 and 18 are independent claims.

Response to Amendments

3. Per Applicants' request, Claims 1, 2, 3, 5, 6, 8, 10, 11, 15, 16 and 18 have been amended.

Response to Arguments

4. Applicants' arguments with respect to claims 1, 2, 3, 5, 6, 8, 10, 11, 15, 16 and 18 in the Remarks filed concurrently with the Amendment have been fully considered but are not persuasive. The following is an examiner's response to Applicants' arguments.

Claims 1 and 11:

Applicant's Arguments:

None of the cited references, taken alone or in any combination, disclose the limitations in the combination of each of these claims of *transmitting environmental information selected by the viewer using an initial menu along with a server address and a viewer's ID number to the server from the TV*. The Examiner admits that Bayrakeri et al. ("Bayrakeri") does not disclose or suggest environmental information adjustments related to broadcast information settings, but asserts that these limitations are disclosed in Lawler at col. 13, lines 18-23. However, Applicant submits that these portions merely relate to selecting programs to be recorded and do not relate to transmitting a download request of

environmental information inputted by the viewer from the TV to the server and transmitting the environmental information corresponding to the request from the server to the TV and do not relate to the environmental information comprising channel settings, and broadcast reservation settings, as recited in the claims of the present application.

Examiner's response:

The Office action, at p. 5, lines 1-4, states “[i]n an analogous art Lawler teaches environmental information adjustments related to broadcast reservation settings (Column 13 lines 18-23 teaches the head end storing a broadcast reservation setting which is a type of program guide data since a program guide is used to set up the reservation setting, and Figure 5).” MPEP 2111, under the heading “Claim Interpretation; Broadest Reasonable Interpretation,” states “[d]uring patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” In view of this practice, the limitation “broadcast reservation settings” is broadly and reasonably interpreted to mean “pre-program the recording device to record the associated program” (13:18-25) because during this process of pre-programming a broadcast channel, the start time, and the end time have to be selected ahead of time (i.e., broadcast reservation settings).

Applicant's Arguments:

The Examiner asserts that Bayrakeri teaches that the custom-IPG is stored for the viewer at the head end. Applicant, however, asserts that Bayrakeri simply discloses that the head end contains the program guide, wherein the program guide is not inputted or stored by the user and that the user merely manipulates the user interface of the program guide. Applicant

asserts that, in the present invention and contrary to Bayrakeri, the viewer selects an initial menu along with a server address and a viewer's ID number, and the selected environmental information is transmitted to the server from the TV to be stored therein. If the viewer can connect the TV to the server, the viewer can download the environmental information stored in the server.

Examiner's response:

Assuming that Applicant is referring to the claimed limitation *storing the environmental information into the server to correspond to the viewer's taste*, the Office action re-asserts that this limitation is clearly anticipated by Bayrakeri, col. 25, lines 7-8.

Applicant's Arguments:

Applicant further submits that there is no suggestion for combining Lawler with Bayrakeri because the limitations in the claims of the present invention do not disclose a recording device or notifying a recording device to record a program as suggested by the Examiner in the motivational statement (Lawler at col. 2, lines 8-13).

Examiner's response:

If the purpose of the present invention, stated in the preamble of Claim 1, is a method for setting environment corresponding to a viewer's taste in a digital TV system including a TV connected with a server and a network, the Examiner's motivational statement of combining Bayrakeri with Lawler for the purpose of notifying the recording device at the user end to record a program when it is available (Column 2 lines 8-13 Lawler) appears to be consistent with the claimed purpose. *Setting to a viewer's taste, environment, and digital TV system*

appear to read on “notifying to record a program when it is available,” “recording device,” and “user end,” respectively.

Applicant's Arguments:

The Examiner asserts that neither Bayrakeri, Lawler nor Etheredge disclose or suggest the method occurring inside a TV but Waterhouse does disclose these limitations. Applicant submits that Waterhouse merely relates to a TV receiving control codes for channel selection contrary to the present invention which relates to a TV transmitting environmental information to a server, as well as transmitting a download request of environmental information to the server, and then receiving the environmental information transmitted from the server in response to the download request.

Examiner's response:

With respect to the requirement that “the method occurring inside a TV,” the Office action assumes that this requirement is implied as the statement of purpose or intended use *a method for setting ... in a digital TV* recited in the preamble of the method claim 1. It is respectfully noted that a preamble is not a limitation if it merely states a purpose or intended use and the remainder of the claim completely defines the invention. *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315 (Fed. Cir. 1988). Even assuming, *arguendo*, that the requirement is in the body of the claim, the requirement is considered met by Waterhouse since Waterhouse discloses the requirement at 4:23-24.

Applicant's Arguments:

The Examiner's asserted purpose in Waterhouse provides no suggestion or motivation for combining Waterhouse with the other mentioned references.

Examiner's response:

As discussed above, since the requirement is not given patentable weight because it is contained in a statement of purpose or intended use in the preamble of the claim method, Applicant's argument regarding the motivation is moot. However, for the sake of argument and responsive to Applicant's assertion that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Waterhouse does disclose a motivation for the combination and the motivation is "not needing a separate supply voltage to power the microprocessor in the set top box."

Applicant's Arguments:

The Examiner admits that neither Bayrakeri, Lawler, Waterhouse, or Etheredge disclose or suggest transmitting a TV address, a server address, a viewer ID number, and a viewer selection environment information from the TV to the server but asserts that Hendricks discloses transmitting a TV address in FIG. 4A, element 924 and col. 17, lines 54-55 and an ID number in FIG. 4B element 928' and col. 17, lines 58-60. Applicant asserts that Hendricks instead discloses information stored at the set top box including address for the set top terminal and that the top terminal identifier is retrieved by the cable head end polling the set top terminal. Applicant asserts that this is not transmitting from

the TV to the server, a server address and a viewer's ID number and that set top terminal identifier 928 is not a viewer's ID number, as recited in the claims of the present application.

Examiner's response:

Without an explicit definition of a "viewer's ID number," the Office action considers that the claimed "viewer's ID number" broadly and reasonably reads on Hendricks' set top terminal identifier. As for the requirement of transmitting from the TV to the server a server address, the Office considers this feature inherent to Hendricks because although not shown in FIGs. 4A-B, a server address need be specified and in the polling message so that the information gathered from the set top terminal knows where to be channeled back to.

Applicant's Arguments:

The Examiner asserts that Donahue discloses transmitting a server address from a TV to the server at col. 7, lines 6-10. Applicant submits that these portions merely disclose that a router receives an input packet of information to examine its source and destination address and determines the optimal output port for the message and that this is not transmitting a server address from a TV to a server along with the environmental information selected by a viewer.

Examiner's response:

The examiner respectfully notes that the limitation "server address" has been deleted from the Currently Amended Claim 2. Therefore, Applicant's argument is moot.

Applicant's Arguments:

Donahue provides no motivation to combine with the other asserted references.

Examiner's response:

Applicant's argument is moot in view of the deletion of the limitation "server address" from the claim.

Claims 7 and 12

Applicant submits that none of the cited references, taken alone or in any proper combination, disclose or render obvious the limitations in the combination of each of claims 1, 7, 11 and 12 of the present application.

In response, Applicant's attention is respectfully directed to the previous Office action, p. 6.

Claims 2 and 3

Applicant submits that none of the cited references, taken alone or in any proper combination, disclose or render obvious the limitations in the combination of claims of 2 and 3 of the present application.

In response, Applicant's attention is respectfully directed to the discussion pertaining to the features recited in these claims in Claims 1 and 11 above.

Claims 4, 14, 16 and 17

Applicant submits that none of the cited references, taken alone or in any proper combination, disclose or render obvious the limitations in the combination of each of claims 4, 14, 16 and 17 of the present application.

In response, the examiner respectfully directs Applicant's attention to p. 14 of the previous Office action.

Claim 6

Applicant submits that none of the cited references, taken alone or in any proper combination, disclose or render obvious the limitations in the combination of claim 6 of the present application.

In response, the examiner respectfully directs Applicant's attention to p. 20 of the previous Office action.

Claim 9

Applicant submits that none of the cited references, taken alone or in any proper combination, disclose or render obvious the limitations in the combination of claim 6 of the present application.

In response, the examiner respectfully directs Applicant's attention to p. 21 of the previous Office action.

Claims 8 and 10

Applicant submits that none of the cited references, taken alone or in any proper combination, disclose or render obvious the limitations in the combination of each of claims 8 and 10 of the present application.

In response, the examiner respectfully directs Applicant's attention to p. 22 of the previous Office action and to the discussion related to the newly added limitation "along with a server address and a viewer's ID number" to the claims in Claims 1 and 11 above.

Claim 13

Applicant submits that none of the cited references, taken alone or in any proper combination, disclose or render obvious the limitations in the combination of claim 13 of the present application.

In response, the examiner respectfully directs Applicant's attention to p. 28 of the previous Office action.

Claim 15

Applicant submits that none of the cited references, taken alone or in any proper combination, disclose or render obvious the limitations in the combination of claim 15 of the present application.

In response, the examiner respectfully directs Applicant's attention to p. 29 of the previous Office action and to the discussion related to the newly added limitation "along with a server address and a viewer's ID number" to the claims in Claims 1 and 11 above.

Claim 18

Applicant submits that none of the cited references, taken alone or in any proper combination, disclose or render obvious the limitations in the combination of claim 18 of the present application.

In response, the examiner respectfully directs Applicant's attention to p. 32 of the previous Office action and to the discussion related to the newly added limitation "along with a server address and a viewer's ID number" to the claims in Claims 1 and 11 above.

In view of the foregoing discussion, the rejections of Claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over the applied prior art references are considered still proper and thus maintained. Notwithstanding the newly added limitations (e.g., *using an initial menu along with a server address and a viewer's ID, viewer's ID number*) to the claims which have been addressed in various parts of the Examiner's response and considered disclosed or suggested by the applied prior art references, the same grounds of rejection of claims 1-18 are maintained. For details of the claim rejections, see previous Office action.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday from 7:15 am to 5:35 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2600 Group receptionist (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



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January 16, 2007